

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 16 recites the limitation "said outer barrel" in line 5-6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-13 and 17-23** are rejected under 35 U.S.C. 102(b) as being anticipated by Keil (US 5,026,189), hereinafter Keil.

Regarding claim 1, Keil discloses a writing instrument having a proximal end and a distal end, said writing instrument comprising:

an inner writing element (48, 49, 44b; see Fig. 7) having a first writing tip (49) and a first writing medium reservoir (44b); and

an outer writing element (47, 44a) having a second writing tip (47) and a second writing medium reservoir (44a);

wherein:

an inner axial passage extends through said second writing tip (47) and said second writing medium reservoir (44a);

said inner writing element (49) is positioned in said inner axial passage through said second writing tip and said second writing medium reservoir (see Fig. 7);

said first writing tip is in direct operative contact with said first writing medium reservoir (see col. 4, lines 36-40);

said second writing tip is in direct operative contact with said second writing medium reservoir (see col. 4, lines 54-58); and

said inner writing element and said outer writing element are axially moveable with respect to each other (see col. 4, lines 54-68).

Regarding claim 2, Keil discloses a driving mechanism (46, 46a, 51, 52) operatively coupled to at least one of said first and second writing elements (see col. 4, lines 58-68).

Regarding claim 3, Keil discloses said driving mechanism is proximal end of said writing instrument (*none of claims 1-3 define which end is the proximal end, thus either end can be considered the proximal end*).

Regarding claim 4, Keil discloses said second writing tip is a nib (*the broadest definition of the term "nib" is a point; Fig. 7 clearly shows second writing tip 47 is a point*).

Regarding claim 5, Keil discloses said nib (47) comprises a connection component (51, 46, 46a) operatively coupling said nib to said second writing medium reservoir (see col. 4, lines 50-65).

Regarding claim 6, Keil discloses said connection component is at least one prong (46a).

Regarding claim 7, Keil discloses said connection component is an open ended cylinder (component 51 is cylinder shaped; see col. 4, lines 54-58 and Fig. 7).

Regarding claim 8, Keil discloses said second writing medium reservoir is a filler-type reservoir (see col. 4, lines 15-19).

Regarding claim 11, Keil discloses said first writing tip is selected from the group consisting of: nib, ball point, roller ball, stylus, chalk, charcoal, and lead. *(The broadest definition of the term "nib" is a point; Fig. 7 clearly shows first writing tip 49 is a point).*

Regarding claim 12, Keil discloses said second writing element is a solid-type writing element *(the second writing element isn't a liquid or a gas thus it must be a solid-type writing instrument).*

Regarding claim 13, Keil discloses said inner writing element has a wall formed from a non-corrosive material. *(Keil discloses the inner and outer writing elements are kept separate by wall 60, thus the wall 60 is at least somewhat non-corrosive to the liquid in the first and second reservoir to some degree).*

Regarding claim 17, Keil discloses a writing instrument having a proximal end and a distal end, said writing instrument comprising:

an outer barrel (42);

a first writing element (47 when concerning claims 18-21; 48, 49 when concerning claim 22) positioned within said outer barrel; and

a second writing element (48, 49 when concerning claims 18-21; 47 when concerning claim 22) positioned within said outer barrel and having a nib-type writing point;

wherein:

said inner and outer writing elements are axially moveable with respect to each other (see col. 4, lines 54-68); and

said outer barrel is configured to permit access to at least one of said inner and outer writing elements (via 46) to remove and to replace said at least one of said inner and outer writing elements.

Regarding claim 18, Keil discloses said outer barrel includes a removable member (46) permitting access to said at least one of said inner and outer writing elements upon removal of said removable member from said outer barrel.

Regarding claim 19, Keil discloses said removable member (46) is a front nose cone (see Fig. 7).

Regarding claim 20, Keil discloses said second writing element (48, 49) has a filler-type writing medium reservoir (44b) (see col. 4, lines 15-19).

Regarding claim 21, Keil discloses a non-porous sleeve (50) covering at least a portion of said writing medium reservoir of said second writing element.

Regarding claim 22, Keil discloses said first writing element (48, 49) extends through an inner axial passage formed through said second writing element (47).

Regarding claim 23, Keil discloses a filler-type instrument comprising:

an outer barrel (42); and

a filler-type reservoir (44b) within said barrel comprising a filler-material saturated with a marking medium (see col. 4, lines 15-22);

wherein:

said outer barrel includes a removable member (46, 51) permitting access to said filler-type reservoir; and

said filler-type reservoir has a non-porous element (50) covering at least a portion of an outer surface of said filler-type reservoir to permit handling of said filler-type reservoir without being soiled by the marking medium therein.

Regarding claim 25, Keil discloses said non-porous element (50) comprises a cartridge case (*element 50 itself is a cartridge case*).

5. **Claims 14-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Bolton (US 2004/016182 A1), hereinafter Bolton.

Regarding claim 14, Bolton discloses a writing instrument having a longitudinal axis, a proximal end, and a distal end, said writing instrument comprising:

an inner writing element having a first writing tip (25; see Fig. 7 and 9) adjacent said distal end of said writing instrument, and a first writing medium reservoir (21; not shown in Fig. 7 but shown in prior Fig.), said first writing medium reservoir having a rear end;

an outer writing element having a second writing tip (43) adjacent said distal end of said writing instrument, and a second writing medium reservoir (8 not shown in Fig. 7 but shown in prior Fig.), said first writing medium reservoir having a rear end; and

a driving mechanism (the screw interaction between 42 and 41; see Fig. 9) operatively coupled to at least one of said inner writing element and said outer writing element;

wherein:

an inner axial passage extends through said second writing tip and said second writing medium reservoir (see Fig. 7);

said inner writing element is positioned in said inner axial passage in said outer writing element;

said inner and outer writing elements are axially moveable with respect to each other (see paragraph [0059]);

said driving mechanism is located at said rear end of at least one of said first or second writing medium reservoirs (see Fig. 7 and 9); and

actuation of said driving mechanism causes axial movement of at least one of said inner and outer writing elements (see paragraph [0059]).

Regarding claim 15, Bolton discloses said driving mechanism comprises a first driving member (42) and a second driving member (41) movably coupled to each other.

Regarding claim 16, Bolton discloses said first driving member is operatively coupled to said inner writing element (see Fig. 7 and 9);

said second driving member is operatively coupled to said outer writing element (see Fig. 7 and 9); and

one of said first and second driving members is coupled to at least a portion of said outer barrel such that movement of said portion of said outer barrel actuates said

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driving mechanism to move one of said writing elements axially (*second driving member 41 makes up the back portion of an outer barrel which surrounds the inner and outer writing elements*).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Keil, as discussed supra.

Regarding claims 9 and 10, Keil fails to disclose the second writing medium reservoir has an oval non-circular cross section. It would be mere matter of design choice to have the second reservoir have a an oval non-circular cross section since the applicant has not disclosed that having the second reservoir have an oval non-circular cross section solves an stated problem an is for any particular purpose and it appears that a second reservoir of any particular shape, including circular, works equally as well.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keil, as discussed supra, in view of Sukhna et al. (US 6,561,713 B2).

Regarding claim 24, Keil discloses a non-porous element but fails to disclose what kind of material the non-porous element is. Attention, however, directed to Sukhna which discloses a filler-type reservoir having a polypropylene wrap (see claim 9) in order to hold the reservoir together. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to have modified the non-porous element of Keil to be polypropylene in view of Sukhna. Such a modification would hold the filler-type reservoir of Keil together.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 1-25** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13, 18-20, 23 and 26 of U.S. Patent No. Bedhome et al. (US 7,147,392 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the patented claims and the present claims are minor and obvious from each other. For example, the differences between claim 1 of the patented invention and claim 1 of the present invention are minor and obvious. Claim 1 of the present invention is a broader version of the patented claim (i.e. claim 1 of the present invention does not include the limitation of an "outer barrel") Therefore, the patented claim 1 would read on the present claim 1 and any infringement over the patented claim 1 would also infringe over the present claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEEGAN GUMBS whose telephone number is (571) 270-5608. The examiner can normally be reached on Monday through Friday 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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